

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Peter Camble et al.

Application No.: 10/033,003

Confirmation No.: 7856

Filed: December 28, 2001

Art Unit: 2145

For: METHOD FOR USING PARTITIONING TO
PROVIDE CAPACITY ON DEMAND IN
DATA LIBRARIES

Examiner: T. M. Hossain

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this Reply Brief is filed within two months of the Examiner's Answer dated January 30, 2007, and is in furtherance of the Appeal Brief filed on November 21, 2005 and the Supplemental Appeal Brief filed March 10, 2006.

No fee is required for this REPLY BRIEF.

This brief contains items under the following headings pursuant to M.P.E.P. § 1208:

- I. Status of Claims
- II. Grounds of Rejection to be Reviewed on Appeal
- III. Argument
- IV. Conclusion

I. STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

There are 23 claims pending in application.

B. CURRENT STATUS OF CLAIMS

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-23
4. Claims allowed: None
5. Claims rejected: 1-23

C. CLAIMS ON APPEAL

The claims on appeal are claims 1-23

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-6, 8, 12, 13-16, and 18 are obvious under 35 U.S.C. § 103(a) over Abboud et al. (U.S. Patent No. 6,636,958, hereinafter *Abboud*) in view of Schubert et al. (U.S. Patent No. 6,742,034, hereinafter *Schubert*).

Whether claims 7, 9-11, 17, and 19-23 are obvious under 35 U.S.C. § 103(a) over *Abboud* in view of *Schubert* and *Darago et al.* (U.S. Patent No. 6,606,664, hereinafter *Darago*).

III. ARGUMENT

Appellant respectfully requests withdrawal of the final rejection, reopening of prosecution, and allowance of the above-captioned application. Should the Appellee not find the

comments contained herein persuasive, acknowledgement of receipt and entry of this Reply Brief are respectfully requested.

Appellant has addressed aspects of the Appellee's responses set forth in the Examiner's Answer dated January 30, 2007 below. The fact that the Appellant does not address a specific issue contained in the Examiner's Answer is not an indication that the Appellant concedes the position asserted by the Examiner. The Appellee's responses are addressed herein in the order in which they appear in the Examiner's Answer.

A. GENERAL COMMENTS

It appears that the Appellee is arguing that the same element in the cited references is the "equivalent" of two different elements in the claims of the present application. Specifically, it appears that the Appellee is asserting that for purposes of the element of partitioning in the present claims and the differentiation of the active sets and the disallowed sets that the same element in the references can be both the separation of active and disabled sets of slot elements and is also the partitioning of the sets of active slot elements. For example, in Schubert the "partitions" are between LUNs that are visible to one host, but not visible to another host. However, in one instant the Appellee has asserted that these non-visible LUNs are the disabled slot elements. See Examiner's Answer page 12. In another instant the Appellee has asserted that these non-visible LUNs are the partitioning of the active slot elements. See Examiner's Answer page 18. The same element cannot be both part of the active set of elements and the disabled set of elements. Similarly, the Appellee asserts that in Abboud the partitioning includes moving the inactive appliance to storage and moving the newly active appliance to the active partition, while at the same time asserting that this is the disabled element. See Examiner's Answer page 11. Therefore, the Appellant respectfully requests withdrawal of the rejections of all claims.

B. REJECTION UNDER 35 U.S.C. §103(A) OVER ABBLOUD IN VIEW OF SCHUBERT

As mentioned in the Appellant's Appeal Brief, to establish a prima facie case of obviousness three basic criteria must be met. That is there must be motivation to combine the references, there must be an expectation of success of the combination, and all of the elements must be taught or suggested. See M.P.E.P. §2143

1. Lack of All Claimed Elements

a. Claim 1

In response to Appellant's arguments, the Appellee admits that Abboud does not teach, per se, the partitioning of elements exclusive of said disabled set. However, the Appellee asserts that "Abboud does teach partitioning a portion of a set of elements, exclusive of certain disabled elements. In Abboud, the disabled element constitutes the inactive server application...." See Examiner's Answer page 11. However, in the present application, the disabled elements are not accessible by end users. In contrast, the "disabled elements" of Abboud are accessible by end users. In Schubert, the Appellee asserts that "disabled slot elements" are created by masking them from a certain host. However, these masked elements are still useable by end users. Hence they are not disabled as set forth in the claim. Therefore, the combination of Abboud and Schubert does not teach or suggest the foregoing limitation.

Next, the Appellee asserts that "Abboud teaches the implementation of flexible partitions, changing partition sizes when a certain appliance requires more memory than the current partition can provide." See Examiner's Answer pages 11-12. The Appellee further asserts that the user "has storage capacity rights for the appliances (because of his/her ability to store appliances), which changes as a result of the now larger appliance." Examiner's Answer page 12. Specifically, in Abboud there is no mention that the user's rights to store data has changed. The user in Abboud just needed more space than the current partition for the appliance has. The user always had the right to store this amount of data as the floating partition is provided to handle this issue. Abboud does not discuss the user not having rights to use the floating partition. Thus, the user in Abboud always has the rights to use the floating partition. Hence, the

user's rights have never changed. Therefore, Abboud cannot teach the element of redefining said sets in response to changes in the storage capacity rights of said end users. Schubert does not teach this either, nor has the Appellee shown otherwise.

Further, the Appellee asserted that the limitation "disallowing access to said disable set by end users of said library" of claim 1 is asserted by the Appellant to include "'all' end users" and that assertion is not consistent with the claim language. See Examiner's Answer page 12. The Appellant asserts that the element "end users of said library" is not a "subset" of end users or even a single end user. No end user can access this set as it is disabled. If an end user can access the set then it is not disabled. The Appellee asserts, because the claim is not limited to "all end users" that Schubert is masking of some storage elements that are masked to certain end users is disallowing access to end users as used in the claims. See Examiner's answer page 12. However, the masked or "disabled" storage of Schubert is available to end users and thus is not disabled. Therefore, it is respectfully submitted that the combination of Abboud and Schubert does not teach or suggest in the entirety all of the limitations of claim 1.

b. Claims 6 and 16

In response to the Appellant's request for a reference under 37 C.F.R. §1.104(d)(2) on page 13 of the Examiner's Answer the Appellee responded by indicating that the limitation of claims 6 and 16 is taught in Iwami, U.S. Patent Application Publication No 2002/0156861. However, the publication provided by the Appellee is in the name of Pierce and is directed towards an "Information Exchange Between Non-Networked Devices Through an Intermediary Device Via a Piconet". The cited sections of this reference have nothing to do with storage service providers or customers thereof and does not address the Appellant's request for a reference or an Affidavit. Therefore, Appellant asserts the rejection of record is improper and should be withdrawn.

c. Claim 13

In response to the Appellant's arguments that neither Abboud nor Schubert teach "disabling a subset of said set of slot elements and data transfer elements," the Appellee asserted

that the storage of the server appliance into a storage partition constitutes the disablement of the subset of the elements, since the user is unable to use these elements. See Examiner's Answer page 15. However, the storage of the "inactive" appliances is not the same as disabling. The appliance in Abboud is stored, and it can be later retrieved for use by the user on demand. Hence the appliance is still usable, and while inactive it is not disabled. In contrast, the disabled storage slot elements of the present application are not useable due to their having been disabled. Therefore, it is respectfully submitted that all limitations of the claim are not taught or suggested by the reference.

2. Lack of Motivation

In response to the Appellant's arguments related to the motivation to combine Abboud and Schubert, and the requirement that both references are directed to solve "precisely the same problem," See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), the Appellee asserted that both references were directed to the provisioning and partitioning of space among users with different needs. Further, the Appellee asserts that both references "generally are drawn to the efficient usage and allocation of storage and memory." See Examiner's Answer page 16. The Appellant respectfully disagrees. Specifically, Abboud is directed to configuring a hard disk for accommodating different sizes of applications during automatic re-provisioning of an appliance server. See Abstract. Schubert, on the other hand, is directed to a masking system that prevents the same LUN in a SAN from being assigned to or controlled by multiple servers. Schubert has nothing to do with the partitioning of space among users with different needs. The users in Schubert have the same needs, and the masking software merely prevents one of the users from controlling the entire system. See Background and Summary. Thus, as Abboud is directed to re-provisioning of a hard drive and Schubert is directed to masking parts of a SAN to prevent one server from taking control of the entire SAN, the two references are not directed to solving "precisely the same problem". Therefore, the Appellee's statements regarding motivation for combining the reference is inaccurate and proper motivation to combine the references has not been made of record.

C. B. REJECTION UNDER 35 U.S.C. §103(A) OVER ABBLOUD IN VIEW OF SCHUBERT IN FURTHER VIEW OF DARAGO

1. Claims 10 and 20

In response to Appellants request for a reference or affidavit in support of the Appellee's position with respect to blocking access to those who do not have sufficient licensing rights, the Appellee cited paragraph 51 of Rojas, U.S. Patent Application Publication No. 20010019605. Rojas is directed to a telephone exchange system. The Appellee has provided no indication that the disclosure of Rojas is applicable to limiting access to data storage capacity. Therefore, Appellant asserts the rejection of record is improper and should be withdrawn.

2. Claims 11 and 21

In response to Appellant's request for a reference or affidavit in support of the Appellee's position with respect to extending of licensed library capacity, the Appellee cited lines 15-56 of Darago as teaching this element. The section cited by the Appellee merely discloses the various types of licenses that have been employed. The section cited allows the user to view more content by paying money. However, this is not the same as extending of licensed library capacity as claimed in the claims, as there is no capacity increase as it relates to data storage capacity. Therefore, it is respectfully submitted that all of the elements of claims 11 and 21 are not disclosed by the combination of references.

3. Claim 17

In response to Appellant's arguments that the combination of Abboud, Schubert and Darago do not teach or suggest the entirety of claim 17, the Appellee asserted that the arguments applied to claims 1, 7 and 13 apply to claim 17. See Examiner's Answer page 18. The Appellee asserts that Abboud, Schubert and Darago teach the partitioning of elements into partitions for use by one customer. However, as discussed above with reference to claims 1 and 13, the combination of Abboud and Schubert does not teach "disabling a set of slot elements [and], disallowing access to said disabled set." The addition of Darago does not remedy this. Further, the cited sections of Abboud and Schubert do not disclose the "partitioning at least a portion of a

set of active slot elements ... into partitions for use by one customer.” Again Darago does not remedy this. Therefore, for similar reasons as those discussed above, with respect to claims 1 and 13, the Appellant asserts that the cited references fail to teach all of the elements of claim 17 in their entirety, and therefore, claim 17 is believed allowable over the cited references.

4. Lack of Motivation

In response to the Appellant’s arguments related to the motivation to combine Abboud, Schubert, and Darago, and the requirement that the references are directed to solve “precisely the same problem,” See *Ruiz*, the Appellee asserted that the references were directed to the use and access of computing resources. See Examiner’s Answer page 19. The Appellant respectfully disagrees. Specifically, Abboud is directed to configuring a hard disk for accommodating different sizes of applications during automatic re-provisioning of an appliance server. See Abstract. Schubert, on the other hand, is directed to a masking system that prevents the same LUN in a SAN from being assigned to or controlled by multiple servers. Schubert has nothing to do with the partitioning of space among users with different needs. The users in Schubert have the same needs, and the masking software merely prevents one of the users from controlling the entire system. See Background and Summary. Darago is directed to managing content already stored on a network. Darago has nothing to do with limiting access to storage capacity. Thus, as Abboud is directed to re-provisioning of a hard drive and Schubert is directed to masking parts of a SAN to prevent one server from taking control of the entire SAN, and Darago to managing content already stored, the references are not directed to solving “precisely the same problem”. Therefore, the Appellee’s statements regarding motivation for combining the reference is inaccurate and proper motivation to combine the references has not been made of record.

IV. CONCLUSION

For the reasons set forth in the Appeal Brief dated March 10, 2006, and as supplemented above, Appellant respectfully contends that each of claims 1-23 are patentable over the applied art. Therefore, Appellant respectfully requests that the Board reverse the final rejections of record so that the present claims may pass to issue.

Respectfully submitted,

I hereby certify that this document is being
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via electronic filing.

Date of Electronic Filing: March 28, 2007

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Date: March 28, 2007